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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/973,004	10/10/2001	William Dale Ritchie	P67205US0	4782
136	7590	11/29/2004	EXAMINER	
JACOBSON HOLMAN PLLC 400 SEVENTH STREET N.W. SUITE 600 WASHINGTON, DC 20004			HENDERSON, MARK T	
			ART UNIT	PAPER NUMBER
			3722	

DATE MAILED: 11/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/973,004

Applicant(s)

RITCHIE ET AL.

Examiner

Mark T Henderson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 14-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 14-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### **Faxing of Responses to Office Actions**

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703)872-9306. This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

1. Claims 1, 2, 16, 17, 24, and 25 have been amended for further examination. Claims 8-13 have been canceled.

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***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-6, 15-21, are rejected under 35 U.S.C. 103(a) as being unpatentable over Steidinger (6,533,325) in view of Charley (6,153,279).

Steidinger discloses in Fig. 3 and 4, a carrier sheet comprising a printed single paper sheet (111) having printed matter from a laser printer (Col. 1, lines 24-57 and Col. 5, lines 43-45), wherein the sheet has business indicia) and a contour on a front face (111a), wherein the printed matter contains card information printed (Col. 1, lines 50-55) in a card area (110) having a contour smaller than the contour of the paper sheet (Fig. 1); a polyfilm patch (112) adhered over the card area and over the card information; a thin flexible laminate patch (115) adhered (by adhesive, 116) on a rear surface (111b) of the card area and extending over the card area; wherein the flexible laminate patch (115) has contour smaller than the contour of the paper sheet and larger than the contour of the card area (as seen in Fig. 4); a die-cut (121 in Fig. 4) delineating the contour of the card area and extending depthwise through the polyfilm patch and paper sheet and only partly into the flexible laminate patch (115, as stated in Col. 8, lines 35-46); and a holding

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means or tabs (or ties as stated in Col. 11, lines 33-62) along the die-cut to hold the card area in the paper sheet; wherein the die cut extends only partly into the flexible laminate patch to define an uncut region (portion of laminate patch left uncut, Col. 8, lines 40-46) which forms a burstable region; and wherein the die cut forms an ornamental shape (rectangle).

However, Steidinger does not disclose wherein the flexible laminate patch is made of magnetic material and forms a magnet card; and wherein the printed matter is a common message.

Charley discloses in Fig. 1, a carrier sheet (S) comprising a printed paper sheet (14) having printed matter (Col. 2, lines 40-46) containing card information; a thin flexible laminate patch of magnet material (12) adhesively secured (acrylic adhesive) secured on a rear surface of the paper sheet; wherein the combination of the card and magnet forms a magnet card which can be used for promotional purposes (Col. 1, lines 10-15).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Steidinger's carrier sheet with a paper sheet having a flexible laminate patch made of magnetic material as taught by Charley for the purpose removably attaching the card to an alternative surface.

In regards to **Claim 4**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place any desirable information on the card, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. The fact

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that the content of the printed matter placed on the substrate may render the device more convenient by providing an end user with a specific type of information document or form does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Therefore, it would have been obvious to place any type of indicia the card area, since applicant has not disclosed the criticality of placing specific information, and invention would operate equally as well with any type of indicia, since the indicia would depend on what the end user wanted.

In regards to **Claim 15**, wherein the other information outside the card area is associated with the card information, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. Therefore, the card and sheet indicia of the Steidinger is capable of being associated with one another.

3. Claims 7, 14 and 22-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Steidinger in view of Charley, and further in view of Peterson (6,019,280).

Steidinger as modified by Charley discloses a carrier sheet comprising all the elements as claimed in Claim 1, and as set forth above. However, Charley does not disclose a paper sheet that

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is machine foldable in panels to constitute a glue fold envelope mailer containing an outer address panel, and an inner printed message form containing the die-cut card in a panel.

Peterson discloses in Fig. 2-4, a paper sheet (10) having foldable panels to constitute a glue fold envelope mailer containing an outer address panel (19, shown in Fig. 5, and an inner printed message (36) containing the die-cut card (30).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Steidinger's and Charley's carrier sheet to include the die-cut card in an envelope mailer as taught by Peterson for the purpose of providing a mailer with a die-cut card to be used as a return postcard.

### ***Response to Arguments***

4. Applicant's arguments with respect to claims 1-30 have been considered but are moot in view of the new ground(s) of rejection.

In regards to applicant's arguments that the prior art does not teach: wherein the flexible laminate patch is made of magnet material and is only partly cut depthwise, the examiner submits that the Steidinger reference is now used to disclose a flexible laminate patch located on a rear surface of the card area, wherein the laminate patch is only cut partly depthwise. The Charley reference has been cited for only disclosing that a flexible laminate patch can be made of a

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magnetic material. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Steidinger's carrier sheet with a paper sheet having a flexible laminate patch made of magnetic material as taught by Charley for the purpose removably attaching the card to an alternative surface.


#### **Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)-872-9302. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

November 23, 2004



A. L. WELLINGTON  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700